

Application No.: 10/005,862

Docket No.: 20136-00328-US

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(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark L. Ernest et al.

Application No.: 10/005,862

Confirmation No.: 2036

Filed: November 8, 2001

Art Unit: 3623

For: AUTOMATED INFORMATION
TECHNOLOGY MANAGEMENT SYSTEM

Examiner: B. Van Doren

REPLY BRIEF

MS Reply Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed March 9, 2007, , the undersigned request that the points raised in this Reply Brief be considered when considering the newly raised issues of the Examiner's Answer.

The Rejection under 35 U.S.C. § 101

The Examiner has maintained that claims 1-9 remain unpatentable under 35 U.S.C. § 101.

On page 4 of the Examiner's Answer dated June 1, 2005, the basis for the rejection of claims 1-9 under 35 U.S.C. § 101 were indicated as the following two-prong test:

- (1) whether the invention is within the technological arts; *and*
- (2) whether the invention produces a useful, concrete and tangible result (emphasis added).

However, it is noted that at page 4 of the latest Examiner's Answer, dated March 9, 2007, states:

Examiner withdraws the 35 USC § 101 rejections of claims 1-9 under the grounds of the claims not being "within the technological arts" (emphasis added). However, the 35 USC §101 rejections of claims 1-9 are maintained on the basis of whether the invention produces a useful, concrete, and tangible result (emphasis added).

That is, the basis of the 35 USC § 101 rejection in the Examiner's Answer of June 1, 2005 includes the term "and" between the two-prongs (i.e., items (1) and (2) above). Thus, it is respectfully submitted that the above-discussed 35 USC §101 rejection cannot be maintained on the basis of "whether the invention produces a useful, concrete and tangible" alone. That is, this rejection is improper.

In addition, it is respectfully submitted that Section 2106(C)2(2)(c) of the MPEP states that consideration of the concept of the "concrete" nature of a claim only occurs after a determination of :

Whether the Claimed Invention is a Practical Application of an Abstract Idea, Law of Nature, or Natural Phenomenon (35 U.S.C. 101 Judicial Exceptions).

A review of the record in the case shows no indication that such a determination has been made. Therefore, in consideration of the above, it is respectfully submitted that the 35 U.S.C. § 101 rejection is improper and should be withdrawn.

The Rejection under 35 U.S.C. § 112

The Examiner has maintained that claim 1 is rejected under 35 U.S.C. § 112, second paragraph. In particular, the Examiner's Answer at page 14 suggests "there is no connectivity between the five steps of claim 1."

Claim 1 has a preamble that recites:

[a] computerized process for managing an integrated information technology (IT) system having a plurality of components and providing a *plurality of services*;

and further discloses a process comprising the steps of five steps of:

- (1) collecting, at each of the components, usage data indicating an amount of use each component receives in providing *each of the services*;
- (2) reporting the usage data of each component for *each service*;
- (3) constructing a valuation function for valuing *each service*,
- (4) correlating *each service* with each component used to provide said *service*; and
- (5) determining from said correlated *services* and components a value of each component and a value to said IT system (emphasis added).

It is respectfully submitted that the references to: "plurality of services," "services" and "each service" that occur throughout the steps of the claim clearly link the five steps and the preamble and establishes connectivity and the definite nature of the claim.

In addition, it is respectfully submitted that one of ordinary skill in the art would clearly recognize how a value for each component of an IT system could provide for "managing an IT system" as recited in the preamble. Moreover, it is respectfully submitted that the preamble is generally not given patentable weight in the claim and thus, should not be at issue in the present application.

Examiner's Reliance on *In re Van Geuns*

The Examiner's Reliance on *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) is misplaced.

The foregoing case is an interference proceeding, wherein the Court of Appeals for the Federal Circuit affirmed the lower court case, which dealt with the patentability of claims which were in an interference count. The question of patentability under 35 U.S.C. § 102 and 35 U.S.C. § 103 was the subject of the appeal. There is no discussion in the case of *any* issue under 35 U.S.C. § 101.

The only requirement for a process claim to be statutory is that the claim requires one or more acts to be performed which define a process. To be statutory, a claimed computer related process must either a) result in a physical transformation outside the computer for which a practical application in a technological art is either disclosed in the specification or would have been known to a skilled artisan or b) be limited to a practical application within the technological arts *In re Allapat* 33F3d. 1543 31 USPQ2d 1556-57 (discussed in MPEP 2106 (IV)(B)(2)(b)(i). The present claims meet this requirement.

Rejections under 35 U.S.C. § 112 and 35 U.S.C. § 102

The undersigned relies upon the arguments in the main brief, as the Examiner's Answer does not raise any other significant new issues.

Dated: May 9, 2007

Respectfully submitted,

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